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10/789,538

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EXAMINER

SAYALA, CHHAYA D

ART UNIT

PAPER NUMBER

1761

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/789,538

**Applicant(s)**

TOWNSEND ET AL.

**Examiner**

C. SAYALA

**Art Unit**

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 31-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 32 and 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Terms such as "extra small", "small" etc. is of indeterminate scope. It is not even clear whether this refers to weight or size. Applicant is strongly urged to refrain from such language based on the other current claims, which are extremely difficult to examine based on the fact that the claims herein are mainly based on physical characteristics.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 31-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over The Nutrient Requirements for Cats and the Nutrient Requirement for Dogs (NRC) references (see PTO-form 892) in view of Paluch et al. (US Patent 6117477) and Coffee

et al. (US Patent 4190679) and further in view of Miller et al. (US Patent 4032665), the "Tux" brochures (cited by applicant, see PTO-form 1449), Repholz et al. (US Patent 4900572), Filipi et al. (US Patent 2004/0005392), Fisher et al. (US Patent 4145447), EP 558774 and Staples et al. (US Patent 5000940).

The Nutrient Requirements for Cats and the Nutrient Requirement for Dogs (NRC) references establish every requirement for animals in different states of growth, as well as for maintenance. Page 4 of NRC for Dogs establishes that energy or food required by dogs is to be based on body weight (claim 36). The reference does not teach the caloric content of each piece, the dimensions of each piece and that one to ten pieces are required to complete the meal.

The fat, protein, carbohydrate and fiber requirements are extensively discussed in the above prior art (claim 41). It would have been obvious to determine such amounts based on an animal's weight and energy requirements. In this regard, see Paluch et al. and Coffee et al. that show such amounts. These products have an outer and inner component, and since they are made from different materials, then claims 39-40 have been met. Coffee et al. teach a textured pet food in the form of a dual textured pet food. [Note the abstract and Example VI]. The dry portion or outer portion includes a protein, fat and carbohydrate. The dual textured pet food has a soft portion (meaty) and a crunchy portion (cereal or kibble like). With regard to Paluch, the reference teaches a dual component animal food which has an outer matrix surround an inner component and the moisture content for the outer matrix (col. 5, lines 25-26). The animal food as taught and described by Paluch provides a unitary, nutritionally

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complete, shelf stable animal (pet) food product (claim 1, claim 45). The outer composition or outer portion comprises a composition, which includes carbohydrates, fats, proteins and combinations thereof. The outer shell composition includes the amount of protein, fat and carbohydrate within the range as claimed by applicant. [Note Tables 1-4]. Col. 8 teaches that the product can be of any size. Note the sizes taught. The cross-sectional area however, could not be located in the reference, neither could the Examiner measure the reference product since the Office is not equipped to prepare prior art products and compare them for such physical characteristics. In this regard, Miller et al. teaches a simulated bone with a diameter of about 1.5", and by a rough estimate, this would have resulted in a cross section of between 0.5 and 2 square inches, + or - a few tenths of a square inch. Also, Miller et al. gives the hardness of his product as a desired level of 250 pounds (col. 5, line 4). It is being estimated that this is comparable to the unit that applicant has used "Max Force" (claim 44), and since Miller et al. state that 250 pounds is desirable, then it must be that 70-520 Max Force falls within that range. If not, it would have been obvious to optimize <sup>to</sup> it the required Max <sub>A</sub> Force to provide the necessary chewing property. A search of "Max Force" in relation to hardness resulted in zero hits. Therefore, a proper comparison could not be made. The "toughness value" given in 'Work' would also have been obvious given that a search did not result in any hits and therefore a comparison could not be made. Applicant must state on the record that he was the first to invent values such as "Max Force" and "Work" so that it can be established that these are patentably distinct.

With regard to claim 32 and 47, it would have been obvious to manufacture the pet food product in various sizes according to the size of the dog, as shown in the "Tux" brochure. The same may be said of the caloric content for each size dog, as is already recommended by the NRC publications. Also as in the "Tux" brochure, it would have been obvious to produce a triangle shape. To modify this shape into other shapes, such as bone-shape or elongated snack would have been a matter of choice, given that a bone-shape is the most common shape in pet foods. It follows therefore, since a bone-shape is known in the art, that the pet would be enabled to hold it in its paws by making it of an appropriate length. This statement is being made based on deduction, since it is not possible for the Office to manufacture prior art products, place it in the dog's paws and make such observations/measurements.

Repholz et al. is applied to establish that making a dual textured pet food product with varying thicknesses and lengths is taught by prior art (see col. 7, col 14). At col. 14, Repholz et al. discuss the size of the pet food with respect to the pet size, showing that such a concept was already known in the art. Filipi also teaches the dimensions of the pet food product at paragraph [0019] and states that the texture entices the pet to chew the product so as to clean its teeth. Prior art is also replete with bone-shaped pet products used for cleaning teeth, such as those cited in applicant's IDS filed 1/28/2005 (see references AB thru' AF). It must be therefore, that prior art products were also tough enough and hard enough to achieve such chewing. The burden of showing that they were not, and that applicant has achieved a tougher product or a harder product is

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being shifted to applicant since the Office is not equipped to prepare prior art products and compare them for such physical characteristics.

Fisher teaches a pet food that is compact, contains the pet's meal and provides teeth cleaning. See col. 2, lines 17-65. The product is said to be dense, and Fisher teaches how to control the brittleness of the product, rendering claim 42 obvious.

Fisher states:

The invention is in essence characterized by a chew-resistant, compacted, self-contained unit which contains the pet's meal. The size and shape will depend upon many factors, such as the size of the dog, the amount of food required for the feeding, etc. For example, the size could be that required for a meal or increments thereof. The shape will depend upon the desired appearance, for example, the shape of a bone, a ball, a ring, an animal, a human, a stick, or any other imaginative, abstract, whimsical, amorphous or actual shape. Shapes are illustrated in the following patents: U.S. Pat. No. 3,104,648, Design Pat. Nos. 202,330, 202,331, 202,332, 207,167, etc.

At col. 6, patentees state:

The extended chew life imparted by the integrity of the unit permits the acting time of any additive or medicinal aid to be prolonged, thus, permitting more efficiency. (4) The unitary construction permits an entire meal to be used as a conditioning tool under a variety of circumstances such as in retrieving, heeling, command control such as the discipline of not eating until given permission.

EP 558774 also teaches a food for dogs in the shape of a bone, that is dual textured. Thus, at the time of making the invention it was already known to provide a pet's meal in the form a single unit, in the shape of a bone.

Similarly Staples et al. state at col. 12, lines 43-50:

The invention composition can be used to reduce and control tartar accumulation on canine teeth. Based upon the weight of commercial Milk Bone.RTM. dog biscuits: 12 small invention dog biscuits per day, 10 medium invention dog biscuits per day, 6 large

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invention dog biscuits per day or 4 extra large invention dog biscuits per day will supply about 1/4 to 1/3 of a dog's caloric requirement.

Thus if the daily caloric requirement for a pet is known as disclosed by the NRC, and it was also known that a whole meal can be fed to a pet in any known shape including a bone as disclosed by Fisher, wherein a hard, non-brittle product is shown to benefit teeth health, and Staples et al. show that it was known to calculate caloric content based on various sized pieces of biscuits, then to divide the daily food ration for a pet into compact pieces or a unitary compacted shelf-stable shape that the pet is accustomed to, such as a bone, would have been prima facie obvious. To optimize the thickness, length and cross-section given Repholz's disclosure would have also been within the realm of ordinary skill.

While the examiner has made a fair and honest attempt to meet applicant's numerous physical characteristics, some of the units not even used in prior art, it is being held that these are either comparable or within the artisan's skill to modify for maximum benefits. The burden is being shifted to applicant to show either that he was the first to invent such characteristics/units or that they are unobvious to the person of ordinary skill in the art based on the applied references. Note that the weight of each piece of food or caloric value of each piece, etc has not been shown by prior art. Nonetheless, when the daily requirement is known and the weight of the dog is known, then based on the number of pieces of compact food being provided, it would have been obvious to calculate the caloric value as well as weight of the pet food, based on

Staples et al. Again, if applicant is the first to invent such calculations or derivations, he should so state on the record as such to forward this application to issuance.

### ***Response to Arguments***

Applicant's arguments filed 5/25/2007 have been fully considered but they are not persuasive.

At page 9 of the Remarks, applicant states that none of the references disclose the caloric content of each piece of food and the weight of the piece. Also, that none show a longitudinal shape with a particular cross section claimed. Additionally, a declaration has been submitted to state that  $\frac{1}{2}$  cup of kibble or  $\frac{1}{3}$  of wet food was compacted into 30 grams of a small piece, etc. In view of the now applied references, it is being held that this is of no patentable moment. Fisher shows a compact bone-shaped food, which is a complete meal. The caloric requirement for a dog based on its weight, is known, and the Staples reference is being provided to show that it was known to calculate calories of a given number of pieces. Therefore, to divide up a pet's meal into a single compact unit or into two or three or four ("compact", suggesting a minimum number of pieces), and to calculate its caloric content to equate it to a day's supply is not inventive. Furthermore, applicant has used physical characteristics such as Max Force, Work, weight of a piece, cross section of a piece, etc. that is impossible to measure and compare for purposes of establishing patentability. However, it must be

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said that it is known in prior art to size a pet food product to fit the bite-size of an animal taking into consideration its weight, age, etc. This is certainly not inventive.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. SAYALA whose telephone number is 571-272-1405.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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